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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/641,021	08/17/2000	Alan B. Cayton	59428-P001US-10020580	4559

29053 7590 01/07/2005

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EXAMINER

OUELLETTE, JONATHAN P

ART UNIT PAPER NUMBER

3629

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/641,021	Applicant(s) CAYTON ET AL.	
	Examiner Jonathan Ouellette	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-101 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-101 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Request for Continued Examination

1. The Request filed on 10/28/2004 for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/641,021 is acceptable and a RCE has been established. An action on the RCE follows.

Response to Amendment

2. Claims 88-101 were added by applicant's amendment on 10/28/2004; therefore, Claims 1-101 are pending in application 09/641,021.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. **Claims 1-21, 28-43, 46, 48-71, 78-79, 81, 83, and 85-101** are rejected under 35 U.S.C. 102(a) as being anticipated by Accuhire (www.accuhire.com, Retrieved from Internet Archive Way Back Machine <www.archive.org>, includes Website Upload Date stamp Screenshot 6/20/2000).
3. As per independent Claim 1, Accuhire discloses a method (system, computer executable program code, or business method) for qualifying candidates for employment

with an employer, said method (system, computer executable program code, or business method) comprising: executing a computer program, said computer program receiving as input from said employer a desired hiring criteria of said employer; based on said desired hiring criteria of said employer, said computer program generating at least one customized application program that is executable to interact with candidates for employment with said employer and determine whether each of said candidates is qualified for employment with said employer (www.accuhire.com, pgs.4-11); allowing said candidates access to the at least one generated customized application program; and responsive to input from each of said candidates to the at least one generated customized application program automatically determining whether each of said candidates qualifies for a position of employment with the employer (www.accuhire.com, pgs.4-11).

4. **As per independent Claims 30, 54, and 62**, Accuhire discloses a system (computer executable program code, or business method) for use in qualifying candidates for employment with an employer, said system (computer executable program code, or business method) comprising: a processor-based device; and a computer program executable by said processor-based device to receive as input desired hiring criteria of said employer and generate at least one application program (www.accuhire.com, pgs.4-11), wherein said desired hiring criteria specifies at least one attribute to be possessed by a candidate to be considered qualified for a position of employment, and wherein said at least one application program is executable to interact with candidates and determine whether each of said candidates qualifies for said position of employment with said employer (www.accuhire.com, pgs.4-11).

5. As per Claim 2, Accuhire discloses wherein said desired hiring criteria includes at least one criteria selected from the group consisting of: candidate's education, candidate's work experience, candidate's possessing a particular license, candidate's language skills, and candidate's computer skills.
6. As per Claim 3, Accuhire discloses wherein said computer program provides a predetermined list of hiring criteria for selection by said employer as said desired hiring criteria.
7. As per Claim 4, Accuhire discloses wherein said computer program allows said employer to input additional hiring criteria not included on said predetermined list.
8. As per Claims 5 and 35, Accuhire discloses wherein said computer program includes a user interface for interacting with said employer to receive as input said desired hiring criteria from said employer.
9. As per Claim 6, Accuhire discloses wherein said computer program receiving said desired hiring criteria further includes: receiving said desired hiring criteria from a user interface.
10. As per Claim 7, Accuhire discloses wherein said user interface is a separate program executable to communicative with said computer program.
11. As per Claims 8, 36, and 57, Accuhire discloses wherein said at least one customized application program is executable to interact with a candidate to enable said candidate to self-administer a qualification session for a position of employment with said employer.

12. As per Claims 9, 37, and 58, Accuhire discloses wherein said at least one customized application program enables access by one or more candidates via at least one communication platform.
13. As per Claims 10, 38, and 59, Accuhire discloses wherein said at least one communication platform includes platforms selected from the group consisting of telephony-based platform, web-based platform, and other processor-based platforms.
14. As per Claims 11, 39, and 60, Accuhire discloses an IVR application that enables access by one or more candidates via telephone.
15. As per Claims 12, 40, and 61, Accuhire discloses wherein said at least one customized application program includes a web-based application that enables access by one or more candidates via a processor-based device via the World Wide Web.
16. As per Claims 13 and 41, Accuhire discloses wherein said generating step includes: generating a plurality of said customized application programs (Figs.2-4).
17. As per Claims 14 and 42, Accuhire discloses wherein each of said plurality of customized application programs is executable to enable interaction with candidates via different communication platforms.
18. As per Claim 15, Accuhire discloses said computer program receiving as input from said employer preferences of said employer as to characteristics of said at least one customized application program.
19. As per Claim 16, Accuhire discloses wherein said computer program receives as input from said employer indication of one or more communication platforms on which said at least one customized application program is to enable access by candidates.

20. As per Claims 17 and 67, Accuhire discloses wherein said at least one customized application program is executable to assist in further screening of candidates beyond determining whether based on said desired hiring criteria said candidates qualify for a position of employment with the employer.
21. As per Claims 18 and 68, Accuhire discloses wherein said at least one customized application program is executable to schedule future testing with a candidate determined based on said desired hiring criteria to be qualified for a position of employment with the employer.
22. As per Claims 19 and 69, Accuhire discloses wherein said at least one customized application program is executable to administer testing of a candidate determined based on said desired hiring criteria to be qualified for a position of employment with the employer.
23. As per Claims 20 and 70, Accuhire discloses wherein said at least one customized application program is executable to schedule a future personal interview with hiring personnel of the employer and a candidate determined based on said desired hiring criteria to be qualified for a position of employment with the employer.
24. As per Claims 21 and 71, Accuhire discloses wherein at least one customized application program interacts with a calendaring program to schedule said future personal interview at a time available for said hiring personnel.
25. As per Claim 28, Accuhire discloses the step of said at least one customized application program outputting to a candidate determined by said customized application program as

not qualifying for a position of employment with the employer one or more reasons for said candidate not qualifying.

26. As per Claim 29, Accuhire discloses the step of storing to a database, information about a candidate received by said at least one customized application.

27. As per Claim 31, Accuhire discloses wherein said processor-based device is a device selected from the group consisting of PC, workstation, laptop computer, and PDA.

28. As per Claim 32, Accuhire discloses wherein said processor-based device is a server computer.

29. As per Claim 33, Accuhire discloses wherein said server computer comprises a web server.

30. As per Claim 34, Accuhire discloses wherein said at least one attribute includes an attribute concerning one selected from the group consisting of: candidate's education, candidate's work experience, candidate's possessing a particular license, candidate's language skills, and candidate's computer skills.

31. As per Claim 43, Accuhire discloses an input device communicatively coupled to said processor-based device to enable candidates to input supplemental materials to said processor-based device.

32. As per Claim 46, Accuhire discloses wherein said at least one application program is executable to electronically communicate said supplemental materials to hiring personnel.

33. As per Claim 48, Accuhire discloses a data storage device communicatively coupled to said processor-based device to enable storage of data received by said at least one application program.
34. As per Claim 49, Accuhire discloses wherein said data storage device is at least one device selected from the group consisting of hard drive, floppy disk, Compact Disc (CD), Digital Versatile Disc (DVD), and other data storage devices.
35. As per Claims 50, 52, 63, and 65, Accuhire discloses wherein said processor-based device is communicatively coupled to a communication network to enable access by said employer / candidates to said computer program via said communication network.
36. As per Claims 51, 53, 64, and 66, Accuhire discloses wherein said communication network is a network selected from the group consisting of: PSTN, wireless communication network, a proprietary network, general purpose processor-based information network, dedicated communication lines, computer network, direct PC to PC connection, LAN, WAN, modem to modem connection, Internet, Intranet, Extranet, or any combination thereof.
37. As per Claim 55 as understood by the examiner, Accuhire discloses wherein said code for presenting and code for generating are part of a common computer program.
38. As per Claim 56, Accuhire discloses wherein said code for presenting and said code for generating are each part of separate computer programs that are capable of communicating with each other.
39. As per Claims 78, 83, 85, and 87, Accuhire discloses wherein said input of employer preferences as to characteristics of said at least one customized application program.

received by said computer program includes at least one selected from the group consisting of: input indicating whether the at least one customized application program is to automatically schedule an interview with candidates determined to be qualified for a position, input indicating whether the at least one customized application program is to interact with a calendaring program to schedule an interview with candidates determined to be qualified for a position, input indicating one or more interviewers with whom an interview is to be scheduled for candidates determined to be qualified for a position, input indicating whether the at least one customized application program is to request supplemental material from candidates determined to be qualified for a position, input indicating whether the at least one customized application program is to forward supplemental material received from qualified candidates to one or more hiring managers, and input indicating whether the at least one customized application program is to schedule future testing with a candidate determined to be qualified for a position.

40. As per Claim 79, Accuhire discloses wherein said generated at least one customized application program operates in accordance with the input employer preferences (Fig.4).

41. As per Claims 81 and 86, Accuhire discloses wherein said computer program is further executable to receive as input preferences of said employer as to operational characteristics of said at least one application program to be generated (Fig.4).

42. As per Claims 88 and 92, Accuhire discloses wherein said computer program receiving as input a desired hiring criteria comprises receiving manually inputted hiring criteria from said employer, and wherein said computer program generating said at least one customized application program comprises said computer program automatically

integrating the manually inputted hiring criteria into the at least one customized application program.

43. As per Claims 89, 90, and 91, Accuhire discloses wherein said computer program receiving as input a desired hiring criteria comprises: receiving said input defining any hiring criteria desired for said position of employment, wherein said input desired hiring criteria is not limited to a selection of hiring criteria pre-defined by said computer program.
44. As per **independent Claims 93 and 99**, a automated employment decision system (method) for use in qualifying candidates for employment with an employer, said system comprising: a processor-based device; and a computer program executable by said processor-based device to receive manual input from a user defining a desired criteria for a position of employment with the employer (www.accuhire.com, pgs.4-11), wherein said input defining a desired hiring criteria is not limited to a selection of hiring criteria pre-defined by said computer program; and said computer program further executable to automatically integrate the defined hiring criteria into an application program that is executable to interact with candidates and determine, based at least in part on the defined hiring criteria, whether each of said candidates qualifies for said position of employment with said employer (www.accuhire.com, pgs.4-11).
45. As per Claims 94 and 100, Accuhire discloses wherein in automatically integrating the defined hiring criteria into said application program, the computer program generates at least one customized application program that is executable to interact with said

candidates and determine, based at least in part on the defined hiring criteria, whether each of said candidates qualifies for said position of employment with said employer.

46. As per Claim 95, Accuhire discloses wherein said automatically integrating comprises: said computer program generating at least one customized application program that is executable to interact with candidates for employment with said employer and determine whether each of said candidates satisfies said at least one qualification criteria.
47. As per Claims 96 and 101, Accuhire discloses wherein receiving said manual input from a user for defining the desired criteria for a position, the computer program is executable to receive as manual input at least one question, and wherein said at least one customized application program presents said at least one question to said candidates.
48. As per Claim 97, Accuhire discloses wherein said receiving as manual input from a user to a computer program at least one qualification criteria further comprises receiving as manual input an indication of at least one answer to said at least one question that satisfy said at least one question, and wherein said at least one customized application program determines whether answers received from said candidates for said at least one question satisfy said at least one question.
49. As per Claim 98, Accuhire discloses wherein receiving as manual input from a user at least one qualification criteria further comprises: receiving said manual input defining any qualification criteria desired for said position of employment, wherein said at least one qualification criteria is not limited to a selection of qualification criteria pre-defined by said computer program.

Claim Rejections - 35 USC § 103

50. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

51. **Claims 22-27, 44, 45, 47, and 72-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Accuhire in view of McGovern et al. (US 5,978,768).**

52. As per Claims 22 and 72, Accuhire fails to expressly disclose wherein said at least one customized application program is executable to forward supplemental materials to hiring personnel of the employer for a candidate determined based on said desired hiring criteria to be qualified for a position of employment with the employer.

53. McGovern teaches wherein supplemental materials (resumes) are forwarded to the hiring contact once a qualified candidate is determined (Fig.7, Figs.28-31, C15 L10-58).

54. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein said at least one customized application program is executable to forward supplemental materials to hiring personnel of the employer for a candidate determined based on said desired hiring criteria to be qualified for a position of employment with the employer, as disclosed by McGovern in the system disclosed by Accuhire, for the advantage of providing a method of screening employment candidates with the ability to increase system effectiveness and efficiency, by providing the employer with additional decision making materials from the potential candidates.

55. As per Claims 23, 44, and 73, Accuhire and McGovern disclose wherein said supplemental materials include at least one of the materials selected from the group consisting of candidate resume, writing sample, questionnaire, letter of recommendation, and school transcript.
56. As per Claims 24 and 74, Accuhire and McGovern disclose wherein said at least one customized application is executable to forward said supplemental materials to hiring personnel electronically.
57. As per Claims 25, 47, and 75, Accuhire and McGovern disclose wherein said at least one customized application is executable to forward said supplemental materials to hiring personnel via at least one communication method selected from the group consisting of e-mail and fax.
58. As per Claims 26 and 76, Accuhire and McGovern disclose the step of said at least one customized application receiving said supplemental materials from a candidate.
59. As per Claims 27, 45, and 77, Accuhire and McGovern disclose wherein said at least one customized application receives said supplemental materials via at least one of the following methods: fax, e-mail, and digital imaging device.
- 60. Claims 80, 82, and 84 are rejected under 35 U.S.C. 103 as being unpatentable over Accuhire.**
61. As per Claim 80, Accuhire does not expressly show wherein said supplemental material includes at least one of the materials selected from the group consisting of: candidate resume, writing sample, questionnaire, letter of recommendation, and school transcript.

62. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The candidate qualifying system/method would be performed regardless of the supplemental material used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
63. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have requested supplemental material which included at least one of the materials selected from the group consisting of: candidate resume, writing sample, questionnaire, letter of recommendation, and school transcript, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.
64. As per Claims 82 and 84, Accuhire does not expressly show wherein said computer program is operable to receive a preference of said employer as to one or more communication platforms in which said at least one application program is to enable access by candidates.
65. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The candidate qualifying system/method would be performed regardless of the communication platform used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

66. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used several types of communications platforms in which said at least one application program is to enable access by candidates, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Response to Arguments

67. Applicant's arguments filed 10/28/2004, with respect to Claims 1-101, have been fully considered but are moot in view of the new ground(s) of rejection.

68. The Declaration of Cayton filed on 12/9/2004 under 37 CFR 1.131 has been considered but is ineffective for the date of 6/12/2000.

69. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Haller's reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

70. Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant had been diligent. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 7333 (Comm'r Pat 1889). Rather, the applicant must show evidence of facts establishing diligence. The Applicant must account for the entire

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period during which diligence is required. Gould V. Schawlow, 363 F.2d 908, 919, 150 USPQ634, 643 (CCPA 1966). A 2-day period lacking activity has been held to be fatal. In re Mulder, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); Fitzgerald v. Arbib, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (Less than 1 month of inactivity during critical period). Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice. An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.); Kendall v. Searles, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (Diligence requires that applicants must be specific as to dates and facts.).

Conclusion

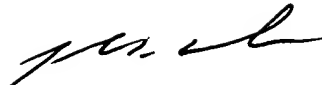
71. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-0662. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
72. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-3597 for After Final communications.
73. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

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December 30, 2004


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